

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Patent Application of Peter Nicholson.

Serial No.: 10/783,434

Art Unit: 3662

Filed: February 20, 2004

Examiner: Gregory C. Issing

Title: ASSISTED GLOBAL POSITIONING SYSTEM LOCATION
DETERMINATION

ELECTION WITH TRAVERSE

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the Office Action mailed July 2, 2009 and telephonic discussion held with the Examiner on July 27, 2009 for the above-identified application. Applicant would like to thank the Examiner for the courtesies shown to Applicant's representative during the telephonic discussion held on July 27, 2009.

Claims 1-61 are pending in the application. The restriction requires election of Group I (Claims 1-32 and 38-61), Group II (Claims 33-34), or Group III (Claims 35-37).

Group Election – Group I

Applicant elects **Group I** (Claims 1-32 and 38-61). Applicant also acknowledges the Office's indication of generic Claims 1, 16, 22, 24, 28, 38, 41, 45, 47 and 56. Should any of the generic claims be allowed, Applicant notes that all species

will be examined on the merits. Applicant rejects any notion that the features in the species are obvious variants of each other without any support or evidence in the record.

Species Election – Species 6 with traverse

The restriction further requires an election of Species 1-6.

Applicant provisionally elects **Species 6** with traverse, namely, “determination of the likelihood on the basis of a plurality of criteria selected from the group of angle of elevation, terrain indicator, elevation model, geometrical spread, and historical data.”

Applicant states that while mutual exclusivity does not exist in the restriction requirement, at least Claims 1, 10-11, 15-32, 38-47, 49-50 and 55-61 should be examined with the election of Species 6.

With the election of Species 6, however, Applicant does not admit, for example, that Claims 10-11 require the elements of Species 6. These claims, do not require any of specific “likelihood” elements for any of the alleged species and thus are generic thereupon. Claims 17-19, 25-26, 29-31, 42, 49-50 and 57-61 also run in a similar vein and should also be examined.

1. Mutual exclusivity does not exist and all of Claims 1-32 and 38-61 should be examined.

Applicant does not understand the Office’s requirement for a species election when mutually exclusivity does not exist between the alleged species. Applicant thus respectfully requests the Office clarify its species election requirement.

Applicant respectfully directs the Office’s attention to MPEP § 806.04(f) which outlines the proper tests for mutual exclusivity: “Claims to different species are mutually

exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first.” See MPEP §806.04(f). The Office’s restriction requirement fails in its two-way mutual exclusivity requirement without regard to Applicant’s election. For example, while Species 1, 2, 3, 4 and 5 appear to disclose elements for their respective species¹ and may be mutually exclusive between each other, Species 6 is directed to a plurality of Species 1-5, recites the specific elements of Species 1-5, and is thus not mutually exclusive with any of Species 1-5. The species requirement by the Office simply fails the two-way mutually exclusivity test required by the MPEP.

The Office’s restriction requirement is made even the more perplexing in view of, for example, Claims 23, 27, 32, 39-40, 43-44 and 46 which require one or more, at least one, or selects from a list including the multiple alleged species. Thus, at least these claims overlap in scope and the Office’s required mutual exclusivity basis also fails in this regard. Further, examination of these claims, Claims 23, 27, 32, 39-40, 43-44 and 46, which are readable on all six alleged species as a function of the “one or more,” “at least one”, and/or “including” language, would require the Office to search and examine the subject matter for all six alleged species. Thus, there is no burden to the Office in the search and examination of all of Claims 1-32 and 38-61, and Applicant respectfully requests prosecution on the merits of Claims 1-32 and 38-61.

¹ The improper species restriction is further compounded by the claim language “determined based, at least in part” of claims in the Office’s recited alleged species (see, e.g., Claims 2-15, 48 and 51-55).

Respectfully submitted,

/pdm/

Patrick D. McPherson

Reg. No. 46,255

Ryan T. Hardee

Reg. No. 57,515

DUANE MORRIS LLP
505 9th Street, N.W., Suite 1000
Washington, DC 20004
Telephone: (202) 776-7800
Facsimile: (202) 776-7801

Dated: July 27, 2009